

Remarks

Upon entry of the foregoing amendment, claims 1, 13, 15, 17-20, 22 and 24-46 will be pending in the instant application. Claims 2-12, 14, 16, 21 and 23 have been canceled without prejudice or disclaimer. Applicants reserve the right to pursue the canceled subject matter in continuing applications. Claims 25-46 have been added to claim embodiments that Applicants regard as the invention. Support for the amendments to the specification and claims is found throughout the specification as filed.

More particularly, support for new claims 25-27 and 31-33 can be found, for example, at pages 72, line 29 to page 76, line 10; at page 136, line 24 to page 137, line 6; Table 1, page 54, row 4 as indicated as "Gene No. 2" of the specification as filed; and original claim 11. Support for new claims 28, 34, 39 and 44 can be found, for example, at page 133, line 4 to page 134, line 30 and Example 9 of the specification as filed. Support for new claims 29, 35, 40 and 45 can be found at page 124, line 1 to page 128, line 14 and Example 23 of the specification as filed. Support for new claims 30, 36, 41 and 46 can be found, for example, at page 135, line 1 to page 137, line 6, and Examples 5 to 8 of the specification as filed. Support for new claims 37-38 and 42-43 can be found, for example, at page 76, line 12 to page 84, line 14, and claim 11 of the specification as filed.

In addition, the title has been amended to more precisely reflect the presently claimed invention. No new matter has been introduced.

Provisional Election With Traverse

Claims 2-12, 14, 16, 21 and 23 have been canceled without prejudice or disclaimer.

The Examiner has required an election under 35 U.S.C. § 121 of one of ten groups cast by the Examiner. The Examiner contends that the individual groupings are distinct, each from each other.

Preliminarily, Applicants point out that new claims 25-29, 31-35, 37-40 and 42-45 fall within the domain of Group II (subgroups 24-46) as cast by the Examiner.

In order to be fully responsive, Applicants hereby provisionally elect, *with traverse*, the invention of Group II (subgroups 24-46), drawn to polypeptides, represented by new claims 25-29, 31-35, 37-40 and 42-45.

Moreover, in order to be fully responsive, Applicants hereby elect subgroup 26, the sequences which correspond to polypeptides encoded by the deposited HCE3C63 cDNA and/or

that having an amino acid sequence disclosed in SEQ ID NO:35. New claims 25-46 read on the elected sequences.

With respect to the Examiner's division of the invention into ten groups and the reasons stated therefor, Applicants respectfully traverse.

Applicants point out, that even where patentably distinct inventions appear in a single application, restriction remains improper unless the examiner can show that the search and examination of these groups would entail a "serious burden". (*See* M.P.E.P. § 803.) In the present situation, the Examiner has failed to make such a showing.

Applicants submit that a search of polynucleotide claims of the invention would provide useful information for examining claims directed to both polynucleotides and the polypeptides encoded by these polynucleotides. In certain of the claims this is especially true because the polynucleotide sequence of these claims is defined in part by the polypeptide that the polynucleotide sequence encodes. Further, Applicants point out that, in many if not most publications, where a published nucleotide sequence is an open reading frame, the authors also include, as a matter of routine, the deduced amino acid sequence of the encoded polypeptide.

Similarly, a search of the polypeptide claims of the invention would clearly provide useful information for the examination of claims directed to antibodies either produced in response to or having affinity for the subject polypeptides. This is because antibodies are frequently defined by the antigens that they are produced in response to and the epitopes to which they bind. Moreover, in many publications where an antibody is described, the antigen that it was produced in response to is also described.

Further, searches of publications directed to polynucleotides and the use of those polynucleotides would clearly be overlapping. This is so because in many, if not most, publications which describe polynucleotides, these molecules are described by their function, characterization and/or expression profile. Thus, a search of polynucleotide claims would also provide the Examiner with art directed to the manner in which the claimed polynucleotides could be used in diagnostic and therapeutic indications.

Moreover, searches of publications directed to polypeptides and the use of those polypeptides would clearly be overlapping. This is so because in many, if not most, publications which describe polypeptides, these molecules are described by their function. Thus, a search of polypeptide claims would also provide the Examiner with art directed to the manner in which the claimed polypeptides could be used to treat disease states.

In view of the above, Applicants submit that the searches for polynucleotides, polypeptides, antibodies, and methods of diagnosing and treating disease states using the proteins of the subject invention would clearly be overlapping. Accordingly, Applicants request that the Examiner reconsider and withdraw the restriction requirement and examine the subject matter of Groups 1-23, 24-46, 47-69, 70-92, 93-115, 116-138, 139-161, 162-184, 185-207 and 208-230 together in the present application.

Moreover, should the Restriction Requirement be made final, Applicants respectfully request that upon indication of allowable subject matter, the Examiner rejoin the claims of Group II (subgroup 26) with Group IV (subgroup 72; method of making polypeptides).

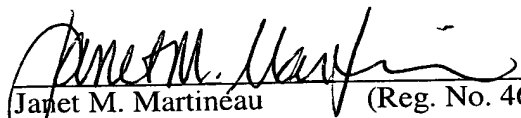
Applicants retain the right to petition from the restriction requirement under 37 C.F.R. § 1.144.

Conclusion

Applicants respectfully request that the above-made amendments and remarks be entered and made of record in the file history of the instant application. If there are any fees due in connection with the filing of this paper, please charge the fees to our Deposit Account No. 08-3425. If a fee is required for an extension of time under 37 C.F.R. § 1.136 that is not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,

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